

Appl. No.: 10/767,534  
Reply to December 28, 2006 Office Action  
Group Art Unit: 1755

**Remarks**

The foregoing amendments and following remarks are responsive to the December 28, 2006, Office Action. Reconsideration is respectfully requested.

**Status of the Claims**

Claims 1 and 40 are amended. Claim 45 is added. Claims 22-30 are cancelled. Claims 33-34 and 44 were cancelled previously. Claims 1-21, 31-32, 35-43 and 45 are pending.

**Support for Amendments/Added Claims**

Claim 1 is amended to clarify the invention. Claim 40 is amended to correct a typographical error. Claim 45 is added. Support for the amendments to Claim 1 and added Claim 45 are found in the specification on page 1, line 10; page 7, lines 20-21; page 8, lines 11-13; page 9, lines 13-15; page 11, lines 15-16; and page 14, lines 3-5. No new matter is added.

**Rejections under 35 U.S.C. § 102(b)**

Claims 1-3, 6-24, 26-32 and 35-41 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,827,453 (Gross). Claims 1-20 and 22-40 were rejected under 35 U.S.C. § 102(a) or (e) as being anticipated by U.S. Patent No. 6,350,787 (Wiggins). Claim 1 (from which Claims 2-3, 6-21, 31-32 and 35-41 depend) is amended to clarify the invention. Claims 22-24 and 26-30 are cancelled, rendering the rejection moot as to those claims.

Gross relates to defoaming compositions for aqueous surfactant systems. Example 1 (cited by the Examiner) illustrates the formation of a reaction product. Although Gross discloses a reaction product in Example 1 similar to the reaction product of Claim 1, the reaction product is added to an aqueous system. Applicants are

not claiming solely the reaction product: Claims 1-3, 6-21, 31-32 and 35-41 define a non-aqueous coating composition with an effective foam-reducing quantity of the reaction product, wherein the non-aqueous coating composition forms a substantially smooth and uniform film when spray-applied to a hard substrate and dried.

None of the compositions of Gross (to which the reaction product is added) is a non-aqueous coating composition as in amended Claim 1. For a reference to anticipate, each element of the claim must be present. Since Gross fails to disclose a non-aqueous coating composition comprising an effective foam-reducing quantity of the reaction product, Gross does not anticipate the subject matter of the above claims, and the rejection should be withdrawn. Reconsideration and withdrawal of the rejection are respectfully requested.

Wiggins relates to defoamers for aqueous systems. Example 7 (cited by the Examiner) illustrates a reaction product (similar to the reaction product of Claim 1) mixed with polyethylene wax and paraffin oil to form a defoamer additive. The defoamer additive is added to an aqueous system, for example, latex paint. Although Wiggins discloses a reaction product similar to the reaction product of Claim 1 dispersed in non-aqueous components (polyethylene was and paraffin oil), Wiggins does not disclose a non-aqueous coating composition with an effective foam-reducing quantity of the reaction product, wherein the non-aqueous coating composition forms a substantially smooth and uniform film coating when spray-applied to a hard substrate and dried. If one skilled in the art were to spray-apply the defoamer additive (which includes a wax and oil) to a hard substrate, it might arguably coat the substrate, but would not dry or form a substantially smooth and uniform film as defined in Claim 1.

None of the compositions of Wiggins (in which the reaction product is dispersed or to which the defoamer additive is added) is a non-aqueous coating composition comprising an effective foam-reducing quantity of the reaction product which forms a substantially smooth and uniform film when spray-applied to a hard substrate and dried

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as in amended Claim 1. For a reference to anticipate, each element of the claim must be present. Since Wiggins fails to disclose a non-aqueous coating composition comprising an effective foam-reducing quantity of the reaction product which forms a substantially smooth and uniform film when spray-applied to a hard substrate and dried, Wiggins does not anticipate the subject matter of the above claims, and the rejection should be withdrawn. Reconsideration and withdrawal of the rejection are respectfully requested.

Rejection under 35 U.S.C. § 103(a)

Claims 21 and 41 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Wiggins. The arguments made above with regard to the inapplicability of Wiggins under 35 U.S.C. §§ 102(a) or (e) are reasserted herein as if set forth at length.

Wiggins fails to disclose, teach, suggest, or provide motivation for a non-aqueous coating composition comprising an effective foam-reducing quantity of the reaction product which forms a substantially smooth and uniform film when spray-applied to a hard substrate and dried as in Claims 21 and 41, regardless of the number of EO groups present. Since there is no teaching, suggestion or motivation to provide a non-aqueous coating composition with an effective foam-reducing quantity of the reaction product which forms a substantially smooth and uniform film when spray-applied to a hard substrate and dried as in Claims 21 and 41 (which depend from amended Claim 1), the rejection should be withdrawn. Reconsideration and withdrawal of the rejection are respectfully requested.

In addition, the Assignee owns the entire interest (100 percent) in Wiggins and the present application. The entire interest in the applications was owned or under obligation of assignment to the Assignee at the time the invention was made. Therefore, Wiggins is disqualified as prior art in any rejection under 35 U.S.C. § 103(a) and the rejection should be withdrawn. Reconsideration and withdrawal of the rejection

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are respectfully requested.

**Double Patenting Rejections/Rejections under 35 U.S.C. § 103(a)**

Claims 1-32 and 35-41 were rejected on the ground of nonstatutory obviousness-type double patenting and under 35 U.S.C. § 103(a) as being unpatentable over Claims 1-5 and 10 of U.S. Patent No. 6,583,185 (Wiggins II). Claims 1-32 and 35-43 were rejected on the ground of nonstatutory obviousness-type double patenting and under 35 U.S.C. § 103(a) as being unpatentable over Claims 1-20 and 22 of U.S. Patent No. 6,572,691 (Brown).

Wiggins II relates to defoamers for aqueous systems. The reaction product, which is similar to the reaction product of Claim 1, may be dispersed in a water-insoluble liquid carrier (multi-component defoamer composition), and added to an aqueous system, for example, latex paint. The water-insoluble liquid carrier in Claim 1 of Wiggins II, however, is not a non-aqueous coating composition comprising an effective foam-reducing quantity of the reaction product which forms a substantially smooth and uniform film when spray-applied to a hard substrate and dried. If one skilled in the art were to spray-apply the multi-component defoamer composition to a hard substrate, it might arguably coat the substrate, but would not dry to form a film as in amended Claim 1.

None of the compositions of Wiggins II (in which the reaction product is mixed or to which the multi-component defoamer composition is added) is a non-aqueous coating composition comprising an effective foam-reducing quantity of the reaction product which forms a substantially smooth and uniform film when spray-applied to a hard substrate and dried. Therefore, regardless of the number of EO groups present, there is no teaching, suggestion or motivation provided by Wiggins II to reach the invention as claimed with any reasonable expectation of success, absent the Applicants' disclosure, and the rejection should be withdrawn. Reconsideration and

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withdrawal of the rejection are respectfully requested.

Brown relates to ink compositions, which include a liquid vehicle and a reaction product. The ink compositions are applied to paper substrates. The reaction product is similar to the reaction product of Claim 1. The liquid vehicle may include a drying oil or a petroleum solvent. Although the liquid vehicle may be non-aqueous, the liquid vehicle of Brown is not a non-aqueous coating composition comprising an effective foam-reducing quantity of the reaction product which forms a substantially smooth and uniform film when spray-applied to a hard substrate and dried.

In contrast, Brown discloses that the ink compositions are applied to paper substrates. If one skilled in the art were to spray-apply the ink composition of Brown to a hard substrate, for example, a wood-sided house, it might arguably coat the substrate, but would not dry to form a substantially smooth and uniform film as in amended Claim 1. In view of the foregoing, there is no teaching, suggestion or motivation provided by Brown to reach the invention as claimed with any reasonable expectation of success, absent the Applicants' disclosure and the rejection should be withdrawn. Reconsideration and withdrawal of the rejection are respectfully requested.

In the event the Examiner maintains the rejection based on Brown, it is believed that the proviso in newly added Claim 45 that the coating composition does not include a printing ink composition overcomes the rejection.

In the event the double patenting rejections are maintained, and an indication of allowable subject matter is provided herein, Applicant reserves the right to submit a Terminal Disclaimer as deemed appropriate with regard to Wiggins II and Brown.

#### Fees

No fees are believed due, but the Commissioner is authorized to charge any fees deemed due (or credit any balance) to Deposit Account No. 50-1177.

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**Conclusion**

It is respectfully submitted that Claims 1-21, 31-32, and 35-45 are in condition for allowance. A Notice of Allowance is respectfully requested. If anything further is needed to advance the allowance of this application, the Examiner is respectfully requested to contact Applicants' attorney at the telephone number indicated below.

Respectfully submitted,

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